REMARKS

Applicants respectfully request reconsideration in view of the amendment and following remarks. Claims 1-11 and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyama *et al.* U.S. Patent No. 5,324,599 ("Oyama"), in view of Ikeda *et al.* Patent No. WO 95/07551 ("Ikeda"), in further view of Friend *et al.* Patent No. WO 91/05089 ("Friend"), and still in further view of Naoi *et al.* U.S. Patent No. 5,723,230 ("Naoi"). The applicants respectfully traverse this rejection.

None of the references teach the combination of features that the applicants' claim. For example, Oyama fails to teach an electrode with a plurality of carbon nanotubes being disentangled and dispersed in the matrix. (see 2nd paragraph on page 3 of the Office Action through 2nd paragraph on page 4).

The Examiner relies upon Ikeda for teaching of an electrode with plurality of nanotubes, which are substantially free of an aggregate of the nanotube and the diameter and length of the nanotube.

The Examiner then asserts at page 4 of the Office Action,

> Thus, it would have been obvious to one of ordinary skill in the art a the time of the invention was made to insert the teaching of Ikeda et al., Friend et al., and Naoi et al., into the teaching of Oyama et al because the carbon nanotubes increase the electrical conductivity of the cathode by forming an effective electrically conductive network throughout the material.

This is where it becomes obvious that the Examiner is speculating, because the applicants cannot find any such teaching in the references.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish

prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Oyama with Ikeda Friend and Naoi.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

A one month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 08577-00024-USCO from which the undersigned is authorized to draw.

Respectfully submitted,

By _____

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Enclosure: One month extension